

REMARKS/ARGUMENTS

Claims 1-3, 5-7, 9-15, 17-19, 21-27, 29-31, 33-39, 41-43, and 45-56 are pending in the present application. Claims 1, 7, 13, 19, 25, 31, 37-39, 41, and 43 are amended. Claims 49-56 are added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness, Claims 1-3, 5, 6, 13-15, 17, 18, 25-27, 29, 30, 37-39, 41, and 42

The Examiner rejects claims 1-3, 5, 6, 13-15, 17, 18, 25-27, 29, 30, 37-39, 41, and 42 under 35 U.S.C. 103(a) as being unpatentable over Stinson et al., U.S. Patent No. 6,786,398 ("Stinson") in view of Anderson et al., U.S. Patent No. 6,021,202 ("Anderson") in view of Zajkowski et al., U.S. Patent No. 6,705,517 ("Zajkowski") in view of Rhoads, U.S. Patent Publication No. 2001/0022848 A1 ("Rhoads"). This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In this case, the Examiner has not met this burden because all of the features of these claims are not found in the cited references as believed by the Examiner. Therefore, the combination of Stinson, Anderson, Zajkowski, and Rhoads will not reach the presently claimed invention recited in these claims.

Amended independent claim 1 of the present invention, which is representative of amended independent claims 7, 13, 19, 25, 31, 37, and 43 with regard to similarly recited subject matter, reads as follows:

1. A method in an automatic teller machine for processing checks, the method comprising:
 - receiving a customer check issued by a customer at the automatic teller machine;
 - scanning the customer check to create an image of the customer check;
 - identifying an amount for the customer check;
 - creating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued, and wherein funds for the amount are guaranteed by the financial institution; and
 - sending a check use alert to customers associated with the account.

With regard to claim 1, the Examiner states:

Re Claim 1: Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising:

Receiving a customer check issued by a customer at the automatic teller machine (Column 1, lines 58-61)

Identifying an amount for the customer check (Column 1, lines 63-64)
Stinson does not explicitly disclose

Creating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued and wherein funds for the amount are guaranteed by the financial institution

Anderson discloses a method and system for processing electronic documents wherein an electronic check is created at an ATM machine (Column 22, lines 63-67) and wherein the funds for the amount are guaranteed by a financial institution (Column 23, lines 5-11). While Anderson does not explicitly disclose printing the new check, it is old and well known to be able to print a hard copy version of an electronic document and furthermore, Zajkowski discloses that negotiable financial instruments like checks can be dispensed from automated banking machines (Column 1, lines 40-43). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Anderson and Zajkowski to the disclosure of Stinson so that a user could convert a first negotiable instrument into a second that is essentially a cash equivalent. A user may not want to simply cash the check for fear of losing a large sum of money, whereas with a check there is a higher degree of security should that instrument be lost or stolen. Furthermore, if the customer can print the new check as a hard copy form, it can be personally transferred to the appropriate recipient.

Finally Rhoads discloses the old and well known method of digital watermarking a security document such as negotiable financial instruments (page 1; paragraph 0008), wherein the security document (check) includes a digital water mark identifying a financial institution for an account on which the customer check is issued (page 2, paragraph 0019). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the digital watermarking procedures of Rhoads to the disclosure of Stinson / Anderson / Zajkowski to provided additional security measures to the check, including discouraging counterfeiting, transferring information through the documents without alerting human viewers to the presence of the information (Rhoads, paragraph 0008), or identifying a financial institution linked to the document (Rhoads, paragraph 0019).

Office Action dated March 2, 2006, pages 2-4.

The Examiner cites Stinson as disclosing a method for cashing a negotiable instrument by "[r]eceiving a customer check issued by a customer at the automatic teller machine (Column 1, lines 58-61) and "[i]dentifying an amount for the customer check (Column 1, lines 63-64)." Office Action dated March 2, 2006, page 2. Even though Stinson teaches receiving a check and identifying an amount of the check, Applicants agree with the Examiner that "Stinson does not explicitly disclose the steps of [s]canning a check to create an image of the check..." and that "Stinson does not explicitly disclose [c]reating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued and wherein funds for the amount are guaranteed by the financial institution." Office Action dated March 2, 2006, pages 5 and 2, respectively. Consequently, Stinson does not teach or suggest these recited claim 1 features.

In addition, Stinson does not teach or suggest "sending a check use alert to customers associated with the account" as further recited in amended claim 1. Support for this amended claim 1 feature may be found in the specification on page 24, lines 5-12. Stinson makes no reference to sending a check use alert to customers associated with the account. As a result, Stinson does not teach or suggest this recited claim 1 feature either.

The Examiner cites Rhoads as disclosing a "method of digital watermarking a security document such as negotiable financial instruments (page 1; paragraph 0008)...." Office Action dated March 2, 2006, page 3. The Examiner also cites Rhoads as allegedly teaching the amended claim 1 feature of scanning the customer check to create an image of the customer check. The Examiner states, "Rhoads discloses a method of producing a security document wherein a check (security document) is scanned (see abstract or paragraph 0019) to create an image of the check (see "photocopied" paragraph 0019)...." Office Action dated March 2, 2006, page 6. Even though Rhoads teaches digital watermarking for security documents, Rhoads also teaches that "[a] photocopier responsive to such markings can take predetermined action if reproduction of a security document is attempted." Rhoads, Abstract. One predetermined action taken by a photocopier responsive to such markings "is simply to interrupt copying, and display a message reminding the operator that it is illegal to reproduce currency." Rhoads, page 8, paragraph 0125. Thus, Rhoads teaches a method to prevent creating an image of a security document containing a digital watermark. As a result, Rhoads teaches away from scanning the customer check to create an image of the customer check as recited in amended claim 1. Therefore, Rhoads does not teach or suggest this claim 1 feature.

Furthermore, Rhoads does not teach or suggest "funds for the amount" of the new printed certified check "are guaranteed by the financial institution" and "sending a check use alert to customers associated with the account" as further recited in amended claim 1. Rhoads makes no reference to guaranteeing certified check funds or utilizing a check use alert. Consequently, Rhoads does not teach or suggest these recited claim 1 features either.

The Examiner cites Anderson as disclosing "a method and system for processing electronic documents wherein an electronic check is created at an ATM machine (Column 22, lines 63-67) and wherein the funds for the amount are guaranteed by a financial institution (Column 23, lines 5-11)." Office Action dated March 2, 2006, page 3. Anderson, column 22, lines 64-67, reads as follows: "The electronic check system is an all-electronic payment and deposit gathering instrument that can be initiated from a variety of devices, such as [a]...ATM machine...." In other words, Anderson only teaches a method for processing a check entirely by electronic means at an ATM machine and does not produce a hardcopy of the check. Hence, Anderson does not teach or suggest "creating a new printed certified

check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued" as recited in claim 1.

Moreover, claim 1 further recites that "funds for the amount" of the printed certified check "are guaranteed by the financial institution." The Examiner cites Anderson, column 23, lines 5-11 as teaching this claim 1 feature. However, Anderson teaches in the above-cited passage that the electronic check system will "authenticate the payer and payee and their respective banks and bank accounts to provide a degree of security to all parties in the transaction." Anderson, column 23, lines 5-11. Authenticating a payer, the payer's bank, and the payer's account to provide a degree of security as taught by Anderson is distinguishable from guaranteeing funds for the amount of the check by the financial institution as recited in claim 1. Just because the payer of an electronic check is authenticated by the method taught by the Anderson reference, as well as the payer's bank and bank account, does not mean that the bank or financial institution guarantees payment of the electronic check. Anderson makes no reference to guaranteeing payment of the electronic check by the financial institution. Consequently, Anderson does not teach or suggest "funds for the amount are guaranteed by the financial institution" as recited in claim 1.

In addition, Anderson does not teach or suggest "sending a check use alert to customers associated with the account" as recited in amended claim 1. Anderson makes no reference to sending a check use alert. Consequently, Anderson does not teach or suggest this recited claim 1 feature either.

The Examiner cites Zajkowski as disclosing "negotiable financial instruments like checks can be dispensed from automated banking machines (Column 1, lines 40-43)." Office Action dated March 2, 2006, page 3. This Examiner-cited passage from Zajkowski teaches that "[o]ther types of automated banking machines may print or dispense items of value such as coupons, tickets, wagering slips, vouchers, checks, food stamps, money orders, scrip or traveler's checks." Zajkowski, column 1, lines 40-43. Even though Zajkowski teaches that an ATM dispenses a physical check, Zajkowski does not teach or suggest "receiving a customer check issued by a customer at the automated teller machine" and "creating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued, and wherein funds for the amount are guaranteed by the financial institution and sending a check use alert to customers associated with the account" as recited in claim 1. In other words, an ATM using the method recited in claim 1 converts one physical check into a new printed certified check containing a digital watermark. Zajkowski does not teach or suggest converting one type of physical check into another type of physical check with a digital watermark. Furthermore, Zajkowski neither makes reference to guaranteeing funds for the amount of the new printed certified check by the financial institution nor to

sending a check use alert to customers associated with the account as recited in claim 1. Therefore, Zajkowski does not teach or suggest these recited claim 1 features.

Moreover, a proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). In this case, no teaching exists in the cited prior art references to combine the references as they are by the Examiner. The Examiner employs hindsight to selectively combine individual features from the cited prior art to reconstruct the Applicants' present invention.

Stinson is directed to a method for automated check cashing that "includes an input device configured to generate input signals in response to inputs from a customer, a storage device including a database of customer information, a check reader configured to receive and read a check to be processed, a cash dispenser, and an electronic processor." Stinson, Abstract. In other words, the method as taught by Stinson only teaches converting a check received from a customer at an ATM into cash. Anderson is directed to a method for creating signed electronic documents using a markup language according to the SGML standard. The various signed electronic document types are preferably defined to satisfy existing customs, protocols, and legal rules. Anderson, Abstract. In other words, Anderson only teaches processing of electronic documents and not physical documents. Rhoads is directed to a method for producing security documents, such as, for example, passports, currency, event tickets, and the like, encoded with machine-readable multi-bit binary information, such as a digital watermark, to prevent photocopying or other types of fraudulent reproduction. Rhoads, Abstract. Zajkowski is directed to a method for configuring an ATM with more secure encryption keys for ATM increased security. Zajkowski, Abstract.

However, the present invention is directed to a method in an automatic teller machine for processing checks that includes capturing an image of a customer in response to receiving a customer check issued by the customer at the automatic teller machine, scanning the customer check to create an image of the customer check, identifying an amount for the customer check, creating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial institution for an account on which the customer check is issued, and wherein funds for the amount are guaranteed by the financial institution, and sending a check use alert to

customers associated with the account as recited in amended claim 1. Consequently, one of ordinary skill in the art would not be lead to combine the teachings of Stinson, Anderson, Zajkowski, and Rhoads to reach the present invention as recited in the claims without using an impermissible hindsight as a blueprint to reconstruct Applicants' present invention.

As a result, the combination of Stinson, Anderson, Zajkowski, and Rhoads does not teach or suggest all features recited in amended independent claims 1, 7, 13, 19, 25, 31, 37, and 43. Accordingly, the rejection of amended independent claims 1, 7, 13, 19, 25, 31, 37, and 43 as being obvious over Stinson in view of Anderson in view of Zajkowski in view of Rhoads has been overcome. In view of the arguments above, amended independent claims 1, 7, 13, 19, 25, 31, 37, and 43 are in condition for allowance. Claims 2, 3, 5, 6, 9, 10, 14, 15, 17, 18, 21, 22, 26, 27, 29, 30, 33, 34, 38, 39, 41, 42, 45, and 46 are dependent claims depending on independent claims 1, 7, 13, 19, 25, 31, 37, and 43, respectively. Consequently, claims 2, 3, 5, 6, 9, 10, 14, 15, 17, 18, 21, 22, 26, 27, 29, 30, 33, 34, 38, 39, 41, 42, 45, and 46 also are allowable, at least by virtue of their dependence on allowable claims.

II. Added Dependent Claims 49-56

Dependent claims 49-56 are added. Support for the features of added claims 49-56 may be found in the specification on page 23, lines 27- 30 and page 24, lines 5-8. Added dependent claims 49-56 also are allowable at least by virtue of their dependence upon allowable independent claims 1, 7, 13, 19, 25, 31, 37, and 43. In addition, these added dependent claims also contain additional features not taught or suggested by the combination of Stinson, Anderson, Zajkowski, and Rhoads.

For example, added dependent claim 49 of the present invention, which is representative of added dependent claims 50-56, reads as follows:

49. The method of claim 1, further comprising:
responsive to receiving the customer check, capturing an image of the customer,
wherein the check use alert includes the image of the customer attached to the image of
the customer check.

As shown in Section I above, the combination of Stinson, Anderson, Zajkowski, and Rhoads does not teach or suggest "sending a check use alert to customers associated with the account" as recited in amended independent claims 1, 7, 13, 19, 25, 31, 37, and 43. Since the combination of Stinson, Anderson, Zajkowski, and Rhoads does not teach or suggest sending a check use alert to customers associated with the account as recited in amended independent claims 1, 7, 13, 19, 25, 31, 37, and 43, then the combination of Stinson, Anderson, Zajkowski, and Rhoads cannot teach or suggest that the check use alert includes the image of the customer attached to the image of the customer check as recited in

dependent claims 49-56. Accordingly, the combination of Stinson, Anderson, Zajkowski, and Rhoads does not teach or suggest this feature recited in added dependent claims 49-56.

III. 35 U.S.C. § 103, Obviousness, Independent Claims 7, 19, 31, and 43

The Examiner rejects independent claims 7, 19, 31, and 43 under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Rhoads. This rejection is respectfully traversed.

Amended independent claim 7 of the present invention, which is representative of amended independent claims 19, 31, and 43, reads as follows:

7. A method in an automatic teller machine for processing checks, the method comprising:
- receiving a check from a customer at the automatic teller machine;
 - scanning the check to create an image of the check;
 - searching the image of the check for an overlaid digital watermark identifying a financial institution for an account on which the check is issued;
 - responsive to identifying the overlaid digital watermark in the image of the check, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs;
 - responsive to the overlaid digital watermark being authentic, providing financial services to the customer; and
 - sending a check use alert to customers associated with the account.

With regard to claim 7, the Examiner states:

Re Claim 7: Stinson discloses a method for processing checks comprising:
Receiving a check from a customer at the automatic teller machine
(Column I, lines 58-61)

Stinson does not explicitly disclose the steps of
Scanning a check to create an image of the check
Searching the image of the check for an overlaid digital watermark
identifying a financial institution for an account on which the check is issued
Responsive to identifying the digital watermark in the image, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs; and
Responsive to the digital watermark being authentic, providing financial services to the customer

Rhoads discloses a method of producing a security document wherein a check (security document) is scanned (see abstract or paragraph 0019) to create an image of the check (see "photocopied" paragraph 0019); Searching the image of the check for an overlaid digital watermark identifying a financial institution for an account on which the check is issued (end of 0019 or FIG 12 "watermark detector"); Responsive to identifying

the digital watermark in the image, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs; (0019) and; Responsive to the digital watermark being authentic, providing the financial services to the customer (see passport example in paragraph 0019; applicable to a bank customer and their account information).

It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Rhoads to that of Stinson in order to provide additional security measures to the check, including discouraging counterfeiting, transferring information through the documents without alerting human viewers to the presence of the information (Rhoads, paragraph 0008), or identifying a financial institution linked to the document (Rhoads, paragraph 0019).

Office Action dated March 2, 2006, pages 5 and 6.

As shown in Section I above, the combination of Stinson, Anderson, Zajkowski, and Rhoads does not teach or suggest all claim limitations as recited in amended independent claims 1, 7, 13, 19, 25, 31, 37, and 43 of the present invention. In particular, as shown above the combination of Stinson and Rhoads does not teach or suggest "scanning a check to create an image of the check" and "sending a check use alert to customers associated with the account" as recited in amended independent claim 7. Consequently, neither Stinson nor Rhoads teach or suggest these recited claim 7 features.

In addition, Applicants agree with the Examiner that "Stinson does not explicitly disclose the steps of comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs, and responsive to the digital watermark being authentic, providing financial services to the customer." Office Action dated March 2, 2006, pages 5 and 6. As a result, Stinson also does not teach or suggest these recited claim 7 features. Even though Rhoads may teach a method for inconspicuously embedding binary data in a digital watermark in security documents, such as negotiable financial instruments, to discourage counterfeiting of the security documents and transferring machine-readable information through such documents (Rhoads, page 1, paragraph 0008), Rhoads does not teach or suggest comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs, and providing financial services to the customer in response to the digital watermark being authentic as recited in claim 7. Rhoads makes no reference to determining whether the overlaid digital watermark is authentic by comparing watermarks for a match.

Rhoads only teaches a method to "discourage counterfeiting" and "transferring information" by using digital watermarks on security documents and does not teach or suggest a method to authenticate

the digital watermarks. Thus, if Rhoads does not teach or suggest "determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs" as recited in claim 7, then Rhoads cannot teach "providing financial services to the customer in response to the digital watermark being authentic" as further recited in claim 7. Hence, Rhoads does not teach or suggest these recited claim 7 features either.

Therefore, the combination of Stinson and Rhoads does not teach or suggest "scanning the check to create an image of the check, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs, providing financial services to the customer in response to the overlaid digital watermark being authentic, and sending a check use alert to customers associated with the account" as recited in amended independent claim 7. As a result, the combination of Stinson and Rhoads does not teach or suggest all features recited in amended independent claims 7, 19, 31, and 43. Accordingly, the rejection of amended independent claims 7, 19, 31, and 43 as being obvious over Stinson in view of Rhoads has been overcome.

IV. 35 U.S.C. § 103, Obviousness, Dependent Claims 9, 10, 21, 22, 33, 34, 45, and 46

The Examiner rejects dependent claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Rhoads as applied to claim 7 above, and further in view of Anderson. This rejection is respectfully traversed.

As shown in Sections I and III above, amended independent claims 7, 19, 31, and 43 are in condition for allowance. Claims 9, 10, 21, 22, 33, 34, 45, and 46 are dependent claims depending on independent claims 7, 19, 31, and 43, respectively. Consequently, claims 9, 10, 21, 22, 33, 34, 45, and 46 also are allowable, at least by virtue of their dependence on allowable claims. Accordingly, the rejection of dependent claims 9, 10, 21, 22, 33, 34, 45, and 46 as being obvious over Stinson in view of Rhoads as applied to claim 7 above, and further in view of Anderson has been overcome.

V. 35 U.S.C. § 103, Obviousness, Claims 11, 12, 23, 24, 35, 36, 47, and 48

The Examiner rejects claims 11, 12, 23, 24, 35, 36, 47, and 48 under 35 U.S.C. § 103 as being unpatentable over Stinson in view of Lemelson, U.S. Patent No. 4,991,205 ("Lemelson") in view of Cuervo, U.S. Patent No. 6,105,009 ("Cuervo"). This rejection is respectfully traversed.

Independent claim 11 of the present invention, which is representative of independent claims 23, 35, and 47, reads as follows:

11. A method in an automatic teller machine for issuing an identification card, the method comprising:
receiving a request from a user at the automatic teller machine to issue the identification card;
verifying an identification of the user;
responsive to the identification of the user being verified, capturing an image of the user;
retrieving user information associated with the user for use in generating the identification card; and
generating the identification card using the image and the user information.

With regard to claim 11, the Examiner states:

Re Claim 11: Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising
Verifying an identification of the user (Column 1 line 67- Column 2 line 2)
Responsive to the identification of the user being verified, capturing an image of the user and retrieving user information associated with the user (Column 2, lines 14-34)

Stinson does not explicitly disclose the steps wherein this information is stored on an identification card and this card is generated at the automatic teller machine.

Lemelson discloses a personal identification system and method wherein one object is to "provide a credit card recording and reproduction system for rapidly and easily recording signals relating to a physical characteristic of the card owner on the card which recording may be reproduced by specialized equipment and employed to generate images of the face and signature of the card owner. (Column 1, line 65- Column 2, line 2)" It would have been obvious to someone skilled in the ordinary art at the time of invention to include the identification card taught by Lemelson to the biometrics verification method of Stinson so that a large central database of names does not need to be kept and referenced every time a person uses an ATM. If the data is stored on an individual card, provided by the user, then the system need only to read the information on the card, therefore saving memory space and money.

Stinson and Lemelson do not explicitly disclose the step of generating the identification card, however Cuervo discloses an automated teller machine dispenser of debit cards that discloses such a step including recording information about a customer and creating and dispensing the card (Fig 1 Ref 20; and Fig 2). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include this step to the disclosure of Stinson and Lemelson so that someone using an ATM for the first time could have an identification card produced for them for future visits so they do not have to waste time in proceeding through a long verification process for each subsequent visit. Producing the card at the ATM vestibule is advantageous as well as a customer can simply perform this action once before their initial transaction as opposed to having to go out of the way to a central office to have a card generated.

Office Action dated March 2, 2006, pages 8-10.

The Examiner cites Stinson as disclosing a method for automatic cashing of a negotiable instrument. Office Action dated March 2, 2006, page 8. Even though Stinson may teach verifying an identification of the user, capturing an image of the user, and retrieving user information associated with the user, Applicants agree with the Examiner that "Stinson does not explicitly disclose the steps wherein this information is stored on an identification card and this card is generated at the automatic teller machine." Office Action dated March 2, 2006, page 9. Therefore, Stinson does not teach or suggest generating the identification card using the image and the user information as recited in claim 11.

This recited claim 11 feature also is not taught or suggested by Lemelson. Lemelson teaches:

...a personal identification system and method for identifying persons subscribing to such system by processing electrical signals derived from recordings of physical characteristics of the person such as voice generated signals or television signals which are digitized and scrambled for security purposes. In one form, a video picture signal of the face and/or signature of a person is digitized and scrambled and the scrambled signals recorded along a track of a record member such as a magnetic strip secured to a credit card, badge, passbook or personal check. When automatic identification is desired to be made the scrambled recording is scanned to reproduce a scrambled electrical signal which is processed to unscramble it. The unscrambled electrical signal derived from the record member is then either employed to modulate a display such as a cathode ray tube to generate an image of the original information such as the image of the face of a person or the persons signature or is compared with a signal derived from detecting a physical characteristic or phenomenon such as the voice of the person detected by a microphone.

Accordingly, it is a primary object of this invention to provide an automatic personal identification system employing electronic means for verifying and authenticating a person presenting a record member to a clerk or guard for use to gain entry to a premise or to authenticate the person for making a purchase or cashing a check.

Lemelson, column 1, lines 18-46.

Monitoring or checking is effected by a clerk or guard, who inserts the magnetic record card of a person to be verified, into a card reader and depresses a read switch, which operates a motor to drive the magnetic record card past a read head. Lemelson, column 3, lines 10-16. As the magnetic record card's magnetic recording material track passes the reproduction head assembly, the magnetically recorded signals on the card are transduced to electrical signals which are amplified by an amplifier and conducted to an unscrambler circuit, which electronically processes the signals and presents them in intelligible forms. Lemelson, column 3, lines 21-28. In other words, Lemelson teaches that the "recordings" on the magnetic record card are "read" by the magnetic reproduction head and that the information contained within the recordings on the magnetic record card is "reproduced." Lemelson, column 3, lines 66-67 and column 4, lines 9-10, respectively.

Even though Lemelson may teach reading the information contained within magnetic recording material and reproducing the information on a monitor, Lemelson does not teach or suggest "generating the identification card using the image and the user information" as recited in claim 11. The Examiner cites Lemelson, column 1, line 65 – column 2, line 2, as teaching this recited feature. Office Action dated March 2, 2006, page 9. This Examiner-cited passage from Lemelson, reads as follows:

Another object is to provide a credit card recording and reproduction system for rapidly and easily recording signals relating to a physical characteristic of the card owner on the card which recording may be reproduced by specialized equipment and employed to generate images of the face and signature of the card owner.

However, reading the Lemelson reference as a whole, the term "recording" used in the immediately preceding passage means reading or copying the information contained within in the magnetic recording material track in order to reproduce the information, such as a face or signature, on, for example, a television monitor. Lemelson, column 5, lines 19-33. Hence, Lemelson only teaches the use of a magnetic record card within a magnetic record card reader for the purpose of obtaining information contained on the magnetic record card for security reasons. Lemelson, figures 1-2 and associated text. Lemelson makes no reference to generating an identification card. In contrast, claim 11 recites generating an identification card using the captured image of the user and the retrieved user information. Therefore, Lemelson does not teach or suggest this feature recited in claim 11. In addition, the Applicants agree with the Examiner that "Stinson and Lemelson do not explicitly disclose the step of generating the identification card...." Office Action dated March 2, 2006, page 9.

The Examiner cites Cuervo as disclosing "an automated teller machine dispenser of debit cards...." Office Action dated March 2, 2006, page 9. Cuervo teaches a system for dispensing and controlling debit cards, which includes a debit card dispenser, an ATM assembly, a computerized clearinghouse, and a telecommunications network connecting them. Cuervo, column 2, lines 7-11. The debit card dispenser is loaded with a stack of debit cards with a digital storage member wherein a unique identifying serial number has been recorded. Cuervo, column 2, lines 15-17. A debit card purchaser initiates the process by entering basic personal information, such as name, address, social security number, mother's maiden name, and personal identification number. Cuervo, column 2, lines 22-27. The information entered by the debit card purchaser is stored in a storage assembly, which is a memory unit within the ATM assembly, through a computer assembly for subsequent transmission to the clearinghouse. Cuervo, column 2, lines 38-40. In other words, the method as taught by Cuervo only dispenses a debit card on which a serial number has been pre-recorded. All other information, such as the debit card purchaser's personal information, is stored in the ATM's memory and not on the debit card

itself. Consequently, Cuervo does not teach or suggest generating the identification card using the image and the user information as recited in claim 11.

As a result, the combination of Stinson, Lemelson, and Cuervo does not teach or suggest all features recited in independent claims 11, 23, 35, and 47. Accordingly, the rejection of independent claims 11, 23, 35, and 47 as being obvious over Stinson in view of Lemelson in view of Cuervo has been overcome. In view of the arguments above, independent claims 11, 23, 35, and 47 are in condition for allowance. Claims 12, 24, 36, and 48 are dependent claims depending on independent claims 11, 23, 35, and 47, respectively. Consequently, claims 12, 24, 36, and 48 also are allowable, at least by virtue of their dependence on allowable claims.

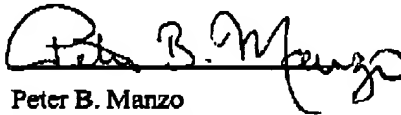
VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited prior art references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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